

REMARKS

In the Final Office Action, dated March 26, 2003, all of the existing claims (1, 4-5, 7-8, 14-15, 19 and 33-42) were rejected under 35 U.S.C. § 103(a) as being unpatentable over Perlman et al. (WO 98/56128, hereinafter Perlman), in view of Ballard et al. (U.S. Pat. No. 6,182,050, hereinafter Ballard), and further in view of Eldering et al. (U.S. Pat. No. 6,457,010, hereinafter Eldering). The existing claims (1, 4-5, 7-8, 14-15, 19 and 33-42) were also alternatively rejected under 35 U.S.C. § 103(a) as being unpatentable over Perlman, in view of Ballard, and further in view of Newman et al. (U.S. Pat. No. 6,085,229, hereinafter Newman).

By this paper, claims 1 and 33 have been amended and new claims 43-47 have been added. Accordingly, claims 1, 4-5, 7-8, 14-15, 19 and 33-47 now remain pending, of which only claims 1, 33, 43 and 44 comprise independent claims.

Of the pending independent claims, claim 1 is generally directed to a method for inserting an advertisement into a document received from a server, wherein the advertisement replaces an existing advertisement in the document. Claim 33 is directed to a computer program product for implementing the method recited in claim 1. Claim 43 is directed to a method for inserting an advertisement into a document received from a server, wherein the advertisement is selected by a client system prior to requesting the document from the server, and claim 43 is directed to a method for inserting an advertisement into a document received from a server, wherein the advertisement is selected based upon a most recently viewed television program.

It will be appreciated that the forgoing claim elements, which have been described in reference to methods and corresponding computer program products for inserting advertisements into documents, distinguish the pending claims from the art of record when considered in their entirety with the other recited claim elements. Accordingly, for at least the foregoing reasons and in view of the following remarks, applicant respectfully requests reconsideration and allowance of the above-identified application and corresponding claims.

As reflected in the Final Office Action, Perlman is generally cited by the Examiner for the proposition that advertisements can be selected and inserted into documents that are sent from a server system to a client system. Ballard is cited by the Examiner for the general teaching that a user's profile can be used to select the advertisements for insertion into the documents. Newman is cited for teaching that documents, such as web pages, can be personalized with personal profile information that are used to determine what content is inserted into the

documents received from a server. And Eldering is cited by the Examiner for the proposition that a user's profile can be based at least in part on television viewing habits and demographics of the user.

None of the foregoing references, however, anticipate or make obvious, either singly or in combination, the claimed methods for inserting advertisements into documents as recited in the pending claims. In particular, the cited references fail to anticipate or make obvious methods for inserting advertisements, in which a client system compiles a user profile, requests an information document from a server, selects an advertisement for insertion into the document, and thereafter inserts the advertisement into the document and displays the document with the advertisement;

wherein the inserted advertisement replaces a preexisting advertisement included in the document, as recited in amended claims 1 and 33,

wherein the advertisement was selected by the client prior to requesting the document, as recited in claim 43, and

wherein the advertisement is selected based upon a most recently viewed television program, as recited in claim 44.

Instead, the cited references actually appear to teach away from some of these claimed embodiments. For example, in Newman, the document received from the server may actually designate space specifically intended for placement of the advertisement (col. 4, ll. 41-50 and 62-64), thereby inherently teaching away from the claimed embodiments of claims 1 and 33 in which preexisting advertisements are overwritten).

In Ballard, disclosure is provided to explain how advertiser's control what advertisements are displayed based on target criteria and playback criteria. For example, Ballard states that "the playback criteria determines the range of dates or times during which the advertisement may be shown." Col. 2, ll. 16-18. Demographics and other affinity rankings can also be used, thereby teaching away from the embodiment in claim 44, where the advertisement is selected according to a most recently viewed television program.

Perlman also provides disclosure that teaches away from embodiments in which advertisements are selected based on a most recently viewed program in stating that advertisements are "better targeted to a user's interests because the ads are targeted based on all

of the data known about the user, not simply the fact the user is viewing a given web page.” (p. 13, ll. 26-28).

Finally, with respect to the embodiment claimed in claim 43, none of the cited references disclose or suggest an embodiment in which a client selects an advertisement for insertion into a document prior to selecting the document that the advertisement is to be inserted into.

Support for the claimed embodiments is found within the specification, as filed. In particular, with regard to claims 1 and 33, the specification states that a selected advertisement can “replace an advertisement already included in information document.” (p. 22, ll. 4-6). In lines 1 and 2 of the same page, it is also stated that a selected advertisement may “be identified before the user requests any Internet resources from the remote server...” (claim 44). Finally, in lines 6-9 of page 17, it is stated how a user profile can be based heavily or solely on the user’s most recently viewed television programming (claim 43).

Accordingly, for at least the foregoing reasons, applicant respectfully submits that the pending claims 1, 4-5, 7-8, 14-15, 19 and 33-44 are now in condition for allowance. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 19th day of June, 2003.

Respectfully submitted,



RICK D. NYDEGGER
Registration No. 28,651
JENS C. JENKINS
Registration No. 44,803
Attorneys for Applicant



022913

PATENT TRADEMARK OFFICE